

Application No. 09/689,263  
Reply to Office Action of July 29, 2003

## REMARKS

On November 25, 2003, Applicants filed two Declarations Pursuant to 37 CFR 1.131, signed by the inventors Milan Mrksich and Yan-Yeung Luk. These Declarations were filed as part of a Request for Reconsideration. In the Advisory Action mailed December 24, 2003, the Examiner states that only the Declaration of Milan Mrksich was attached to the Request for Reconsideration. Thus, the Examiner asserts that the Declarations are defective, due to a lack of the signature of both inventors.

Applicants respectfully point out that both the Declaration of Yan-Yeung Luk and the Declaration of Milan Mrksich were included with the Request for Reconsideration filed November 25, 2003. As evidence of the contents of this filing, a copy of the Return Postcard for the submission is attached. This Return Postcard was stamped by the Office of Initial Patent Examination (OIPE) on December 1, 2003, acknowledging the receipt of the items listed on the card. The items listed on the Return Postcard include a "Declaration of Milan Mrksich" and a "Declaration of Yan-Yeung Luk." Attached for the Examiner's convenience is a copy of the Declaration of Yan-Yeung Luk, as previously submitted as part of the Request for Reconsideration filed November 25, 2003.

Applicants submit that the Declarations Pursuant to 37 CFR 1.131 are complete. In these Declarations the declarants, inventors Milan Mrksich and Yan Yeung Luk, state that they had completed, in the United States, the invention described and claimed in the present application prior to August 12, 2000, the earliest publication date of Chapman et al. (*J. Am. Chem. Soc.* 2000, 122 (34), 8303-8304). Accordingly, Chapman et al. is not a proper reference under 35 U.S.C. § 102(a), and the rejections of the claims under 35 U.S.C. § 102(a) or 103(a) over Chapman et al., under 35 U.S.C. § 103(a) over Mrksich et al., Hodneland et al. (I), Houseman et al. or Sigal et al., in view of Chapman et al., and under the judicially created doctrine of obviousness-type double patenting over claims 1-117 of U.S. Patent Application Serial No. 09/923,760 or claims 1-41 of U.S. Patent Application Serial No. 09/797,166, in view of Chapman et al. have been overcome. Applicants respectfully request that these rejections be withdrawn.

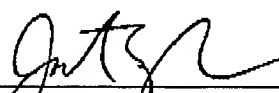
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### Conclusion

It is respectfully submitted that all of the presently presented claims are in condition for allowance. Should the Examiner feel a discussion would expedite the prosecution of this application, the Examiner is kindly invited to contact the undersigned.

Respectfully submitted,

1/14/04

  
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Serial No. 09/689,263  
Applicant: MILAN MRKSICH ET AL.  
Case/Matter No.: 7914/42  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450



Please acknowledge receipt of the below identified:  
Items Mailed: Transmittal letter (2), Petition for Extension of Time,  
check, Request for Reconsideration, Corrected Supplemental Information  
Disclosure Statement, Form PTO-1449 with reference, Declaration of Milan  
Mrksich, Declaration of Yan-Yeung Luk and return postcard.

BRINKS HOFER GILSON & LIONE  
By: Jonathan P. Taylor, Ph.D., Reg. No. 48,338  
Date of Mailing: November 25, 2003

DEC 1 6 2003



Carlsbad Caverns National Park, NM

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